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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/690,549	10/17/2000	Oleg B. Rashkovskiy	INTL-0476-US(P10023)	2613

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EXAMINER	
DEMICCO, MATTHEW R	
ART UNIT	**PAPER NUMBER**
2611	

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/690,549	RASHKOVSKIY, OLEG B.	
	Examiner	Art Unit	
	Matthew R Demicco	2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 August 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-32 and 43-46* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-32 and 43-46* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *8/13/04, 8/23/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This action is responsive to a Request for Continued Examination filed 8/2/04. Claims 1-32 and 43-46 are pending. Claims 1, 12 and 23 are amended. Claims 43-46 are new. Claims 32-42 are cancelled.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-5, 9-16, 20-26, 30-32 and 43-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,815,671 to Morrison in view of U.S. Patent No. 6,216,112 to Fuller et al. as disclosed by Applicant.

Regarding Claim 1, Morrison discloses a method comprising storing an advertisement (Col. 3, Lines 28-32) for playback with content (Col. 3, Lines 34-43). Morrison further discloses automatically replacing the stored advertisement (Col. 2, Lines 55-67 and Col. 6, Lines 26-42). What is not disclosed, however, is replacing in response to receipt of another advertisement selected to specifically replace the stored advertisement. Fuller discloses and advertising system wherein a determination is made whether a new advertisement is needed to replace an old one based on the number of times the old ad has been viewed or after a certain amount of time has elapsed (Col. 11,

Lines 32-44). If such a determination is made, a new advertisement is downloaded and saved to replace the old advertisement (Col. 11, Lines 54-56). This reads on the claimed replacing an ad in response to receipt of another ad specifically selected to replace it. Fuller is evidence that ordinary workers in the art would appreciate the ability to specifically replace an old advertisement with a new one after a certain amount of usage. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Morrison with the specific ad replacement of Fuller in order to prevent old ads from growing "stale" and ineffective by replacing them with fresh ads.

Regarding Claim 2, Morrison in view of Fuller disclose a method as stated above in Claim 1. Morrison further discloses a method wherein storing an advertisement for playback with content includes storing an advertisement in a separate memory location from the content (Col. 3, Lines 28-32).

Regarding Claims 3 and 4, Morrison in view of Fuller disclose a method as stated above in Claim 1. Morrison further discloses including providing a marker in the content to indicate where the advertisement should be inserted (See Figure 4A and Col. 3, Lines 39-63). This marker contains a message code flag for identifying the message material to be inserted and is used to find the material stored on the receiver. This reads on the claimed provision of a pointer with the marker to locate the advertisement in memory.

Regarding Claim 5, Morrison in view of Fuller disclose a method as stated above in Claim 4. Morrison further discloses playing back stored content (Col. 4, Lines 55-61),

identifying the marker (Col. 7, Lines 16-20) and accessing the advertisement using the pointer (Cols. 7-8, Lines 66-4) as stated above.

Regarding Claim 9, Morrison in view of Fuller disclose a method as stated above in Claim 1. Morrison further discloses updating stored advertisements (Col. 2, Lines 55-60).

Regarding Claim 10, Morrison in view of Fuller disclose a method as stated above in Claim 9. Morrison further discloses a method wherein commercial messages are grouped together and transmitted to the receivers a number of times during the day (Col. 6, Lines 26-29). It is inherent that the receiver be adapted to determine when the messages are to be transmitted so it can record them. This reads on the claimed obtaining information about when to update stored advertisements and automatically updating the ads in accordance with the information.

Regarding Claim 11, Morrison in view of Fuller disclose a method as stated above in Claim 9. As stated above, the commercial messages are "transmitted at a number of convenient times through a 24 hour day." This reads on the claimed periodically, automatically updating the stored advertisements.

Regarding Claims 12-16 and 20-22, see Claims 1-5 and 9-11 above.

Regarding Claims 23, Morrison discloses a system comprising a processor-based device (See Figure 2) wherein advertisements and content are stored in separate memory areas of a memory coupled to the processor-based device (28) as stated above. Morrison discloses only a single memory device. This reads on the claimed first random access storage to store content and the second random access storage to store an advertisement

for playback with content. Further, it is inherent that any such processor-based device must execute a software code to operate and that this software code must reside in a memory. One function of this software code is to enable the device to automatically replace the stored advertisements as stated above. This reads on the claimed third random access storage coupled to the processor-based device to store instructions.

What Morrison does not disclosed, however, is automatic replacement induced by the receipt of a replacement designated to specifically replace the stored advertisement. Fuller discloses and advertising system wherein a determination is made whether a new advertisement is needed to replace an old one based on the number of times the old ad has been viewed or after a certain amount of time has elapsed (Col. 11, Lines 32-44). If such a determination is made, a new advertisement is downloaded and saved to replace the old advertisement (Col. 11, Lines 54-56). This reads on the claimed automatic replacement induced by the receipt of a replacement designated to specifically replace the stored advertisement. Fuller is evidence that ordinary workers in the art would appreciate the ability to specifically replace an old advertisement with a new one after a certain amount of usage. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Morrison with the specific ad replacement of Fuller in order to prevent old ads from growing "stale" and ineffective by replacing them with fresh ads.

Regarding Claim 24, Morrison in view of Fuller disclose a system as stated above in Claim 23. Morrison further discloses a system comprising a television broadcast receiver (Col. 5, Lines 1-14) with a tuner, memory and a processor (See Figure 2). What

is not disclosed, however, is that the receiver is a set top box. Official Notice is hereby taken that it is well known in the art to use a set top box format for a television tuner with expanded functionality over a television. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to implement the system of Morrison in the set top box of the well-known prior art in order to implement the invention on ordinary television systems.

Regarding Claim 25, Morrison in view of Fuller disclose a system as stated above in Claim 23. What is not disclosed, however, is a first, second and third storage that are part of the same memory. Official Notice is hereby taken that it is well known in the art that a single memory device may store multiple different sets of data including program instructions and content data. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Morrison in view of Fuller with the memory of the well-known prior art to store programming code, television content and advertising in a single memory in order to reduce costs. This reads on the claimed first, second and third storages being part of the same memory.

Regarding Claim 26, Morrison in view of Fuller disclose a system as stated above in Claim 23. Morrison further discloses the provision of a marker in the content to indicate where an advertisement should be inserted during playing of the content as stated above in Claim 3. It is inherent that there must be programming adapted to utilize this functionality and that it would be stored in the memory device as stated above.

Regarding Claims 30 and 31, see Claims 10 and 11 above.

Regarding Claim 32, Morrison in view of Fuller disclose a system as stated above in Claim 23. Morrison further discloses a connection to a television distribution system (Col. 4, Lines 37-61).

Regarding Claim 43, Morrison in view of Fuller discloses a method as stated above in Claim 1. Fuller further discloses that the new advertisement replaces the old advertisement on the hard disk (Col. 11, Lines 54-56). This reads on the claimed storing the replacement in the same location as the previously stored advertisement.

Regarding Claim 44, Morrison in view of Fuller discloses a method as stated above in Claim 1. Morrison further discloses program material distributed with program break flags to indicate commercials (Col. 3, Lines 5-15 and Col. 6, Lines 29-40). These flags read on the claimed insertion of a marker into the ongoing content record to indicate where the advertisement should be inserted as stated above in Claim 3. Further, it is inherent that the received advertisement updates must be identified in order for the receiver to properly store and recall them for playback.

Regarding Claim 45, see Claim 4 above.

4. Claims 6-8, 17-19, 27-29 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morrison in view of Fuller et al. and further in view of U.S. Patent No. 6,425,127 to Bates et al.

Regarding Claim 6, Morrison in view of Fuller disclose a method as stated above in Claim 1. What is not disclosed, however, is determining whether an advertisement to be stored was previously stored. Bates discloses a method for transmitting and storing

commercial messages at a user's receiver (See Abstract) wherein a determination is made whether an advertisement to be stored was previously stored (Col. 4, Lines 48-53). If the advertisement was not previously stored, the advertisement is stored. Bates is evidence that ordinary workers in the art would appreciate the benefit of storing only those advertisements that have not yet been stored. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Morrison in view of Fuller with the determination of Bates in order to only store ads that have not previously been stored in order to reduce bandwidth usage or disk I/O requirements.

Regarding Claim 7, Morrison in view of Fuller and further in view of Bates disclose a method as stated above in Claim 6. It is inherent in such a system as stated above that a list of stored advertisements must be kept and new advertisements must be compared to the list in order to make a determination of whether an ad was previously stored. This reads on the claimed maintaining a list of stored advertisements and comparing information about a new advertisement to information about advertisements listed on the list.

Regarding Claim 8, Morrison in view of Fuller and further in view of Bates disclose a method as stated above in Claim 7. Bates teaches storing an advertisement if it was not previously stored as stated above.

Regarding Claims 17-19, see Claims 6-8 above.

Regarding Claims 27-29, see Claims 6-8 above.

Regarding Claim 46, see Claims 3 and 4 above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew R Demicco whose telephone number is (703) 305-8155. The examiner can normally be reached on Mon-Fri, 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (703) 305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MRD

mrd
November 4, 2004

CHRIS GRANT
PRIMARY EXAMINER